



UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/748,591	06/14/05	KOHL	0610561

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EXAMINER	
FARVJ	
ART UNIT	PAPER NUMBER
121	4

DATE MAILED: 06/10/06

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice re Patent Drawing, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449
- ☐ Notice of informal Patent Application, Form PTO-152
- ☐ Information on How to Effect Drawing Changes, PTO-1474
- ☐ \_\_\_\_\_

Part II SUMMARY OF ACTION

- ☐ Claims 1-25 are pending in the application.  
Of the above, claims 20, 23 are withdrawn from consideration.
- ☐ Claims \_\_\_\_\_ have been cancelled.
- ☐ Claims \_\_\_\_\_ are allowed.
- ☒ Claims 1-19, 21, 22, 24, 25 are rejected.
- ☐ Claims \_\_\_\_\_ are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
- ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
- ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
- ☒ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-19, 21, 22, 24, 25, drawn to benzimidazolyl pyridines, classified in Class 514, subclass 338; class 546, subclass 271.

II. Claim 20 part a, drawn to a process of preparing the compounds of group I, classified in Class 546, subclass 271.

III. Claim 20 part b, drawn to another process of preparing the compounds of group I, classified in Class 546, subclass 271.

IV. Claim 20 part c, drawn to another process of preparing the compounds of group I, classified in Class 546, subclass 271.

IV. Claim 20 part e, drawn to another process of preparing the compounds of group I, classified in Class 546, subclass 271.

IV. Claim 23, drawn to a composition of group I compound with a known gastric acid secretion inhibitor, classified in Class 546 or 548, subclasses of different places.

The inventions are distinct, each from the other, because of the following reasons:

Inventions I and VII are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in a materially different combination. MPEP 806.05(c).

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In this case, the combination as claimed does not require the particulars of the subcombination for patentability because different combination of known gastric acid secretion inhibitors serve the same purpose. Additionally, the subcombination has separate utility such as intermediates.

Inventions I, II, III, IV, V, and VI are related as process of making and product made.

The inventions are distinct if either (1) the process as claimed can be used to make another and materially different product, or (2) the product as claimed can be made by another and materially different process. MPEP 806.05(f).

In this case, the products can be made by different methods as evidenced by (a) to (e).

Because these inventions are distinct for the reasons given above and the search required for group I is not required for groups II to VII restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Aisenberg on May 1st, 1986 a provisional election was made with traverse to prosecute the invention of group I, claims 1-19, 21, 22, 24, 25. Affirmation of this election must be made by applicant in responding to this Office action. Claims 20, 23 are withdrawn from further consideration by the examiner as being drawn to a non-elected invention. See 37 CFR 1.142(b).

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The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-19, 21-22, 24-25 are rejected under the judicially created doctrine of <sup>(1)</sup>obviousness-type double patenting as being unpatentable over the prior invention as set forth in claim 5 of U.S. patent no. 4555518 or 4560693 in view of 4255431.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of monopoly by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Claims 1-19, 21, 22, 24-25 are rejected under 35 <sup>(2)</sup>U.S.C. 103 as being unpatentable over pat. 4555518 or 4560693 in view of 4255431.

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Rainer [I and II] teach the claimed compounds. The only difference between the claimed compounds and the art one is in the R<sub>2</sub> or R<sub>4</sub> group. However, the secondary reference Junggren et al. teaches the interchangeability between alkyl and alkoxy rendering the claimed compounds obvious.

Claims 1-19, 21, 22, 24-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending application serial no. 794230. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain overlapping subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of monopoly by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Claims 1-19, 21, 22, 24-25 are directed to an invention not patentably distinct from claims of commonly assigned 794230. Specifically, they contain overlapping subject matter.

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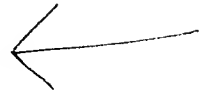
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There is no information of record indicating that the conflicting inventions were commonly owned at the time the invention in this application was made.

The assignee is required under 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention was made will preclude a rejection under 35 U.S.C. 103 based on this subject matter but will not preclude a rejection on the grounds of obviousness double patenting (37 CFR 1.78(d)). An obviousness-type double patenting rejection based upon this subject matter may be obviated by filing a terminal disclaimer under 37 CFR 1.78(d).



Claims 1, 2, 3, 22, 24, 25 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following reasons apply:

1. The word "optionally" is indefinite. The words "unsubstituted or substituted completely or partly by--] would overcome this rejection.

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2. Claims 22-23 fail to recite "an intended use". the term "medicament composition" is so broad which encompass viral, cardiac, arthritic and the like for which no base can be found in the disclosure.

3. Claims 24-25 fail to recite "an effective amount" of the active ingredient. The claims now read on toxic or ineffective amount of the active ingredient.

Applicants' presentation of prior art statement and accompanying references is noted with appreciation. The references have been placed of record in the file.

Fan:st  
A/C 703  
557-3920  
5-20-86  
Retyped 6-9-86

*Jane T. Fan*  
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PRIMARY EXAMINER  
ART UNIT 121